

MAR 23 2006

DB&R**Drinker Biddle & Reath**
L L POne Logan Square
18th & Cherry Streets
Philadelphia, PA 19103-6996
■ 215-988-2700

FACSIMILE INFORMATION SHEET

TO: Office of Initial Patent Examination FROM: Daniel A. Monaco DIRECT DIAL: 215-988-3312

DATE: March 23, 2006 DOCUMENT NAME: Petition

NUMBER OF PAGES: INCLUDING COVER 30

TELEPHONE NUMBER: FAX NUMBER: 1-703-308-7751

IF YOU DO NOT RECEIVE THIS FAX DOCUMENT IN ITS
ENTIRETY, PLEASE CALL DENISE COLLINS AT 215-988-2566
DB&R FACSIMILE MACHINES
215-988-2757

Message:

Attached is a Petition to Withdrawal Holding of Abandonment.

Client/Matter No.: 42970-0007CI1 (182540)

☒ Original will not follow

Original will follow via: Regular Mail Overnight Delivery Hand Delivery Other:

The pages which follow are confidential and/or privileged. They are intended solely for the person to whom this cover sheet is addressed. Any review, reproduction or retransmission of such material by any person other than such addressee is unauthorized. If this cover sheet and the pages which follow have been received at your location in error, please notify the operator by telephone (collect) at the number set forth above and return the material U.S. First-Class Mail without inspection. We will reimburse your postage. Thank you for your cooperation.

CERTIFICATE OF FACSIMILE
TRANSMISSION

I hereby certify that this correspondence, along with any paper referred to as being attached or enclosed, is being facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below.

BY Denise M. Collins

DATE: March 23, 2006

PHIP\504532\1

BEST AVAILABLE COPY

MAR 23 2006

PATENT

Attorney Docket No.: 42970-0007CII

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of Sukanta Banerjee, et al. : Group Art Unit:
1645
:
Appln. No.: 10/032,657 : Examiner:
Not Yet Assigned
:
Filed: December 28, 2001 : Confirmation No.:
6168
:
For: Multianalyte Molecular Analysis Using :
Application-Specific Random Particle Arrays :

PETITION TO WITHDRAWAL HOLDING OF ABANDONMENT (37 CFR 1.81 (a))VIA TELEFAX: 1-703-308-7751**Office of Initial Patent Examination**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

This is in response to the Notice of Abandonment mailed March 9, 2006 (copy enclosed).

The Notice of Abandonment alleges that the application was abandoned for failure to timely reply to the Notice to File Missing Parts mailed January 29, 2002.

**CERTIFICATE OF FACSIMILE
TRANSMISSION**

I hereby certify that this correspondence, along with any paper referred to as being attached or enclosed, is being facsimile transmitted to the U.S. Patent and Trademark Office on the date indicated below.

BY

DATE:

Mr. Dennis A. Collins
March 23, 2006

PHIP504441\1

A complete reply to the Notice to File Missing Parts was filed by applicants by U.S. Express Mail on May 6, 2002. A complete copy of that submission is contained herewith in Appendix A, comprising the following documents:

- Response to Notice to File Missing Parts of Application;
- Copy of Notice to File Missing Parts;
- Executed Combined Declaration and Power of Attorney;
- Petition for two month extension of time;
- Check in the amount of \$65.00 for Missing Parts fee;
- Express mail certificate for express mail label No. EV 094 892 595 US;
- Check in the amount of \$200.00 for extension of time; and
- Postcard

Contained in Appendix B is a true and correct photocopy of the PTO-stamped return postcard evidencing the USPTO's receipt of the materials of Appendix A on May 6, 2002.

Contained in Appendix C is a true and correct photocopy of the Express Mail label from the express mailing of the items collected under Appendix A. The label bears the U.S. Postal Service's "date-in" of May 6, 2002.

It is respectfully submitted that the May 6, 2002 Response to Notice to File Missing Parts of Application constituted a complete response to the January 29, 2002 Notice to File Missing Parts. Applicants therefore respectfully petition for withdrawal of the Notice of Abandonment.

No fee is believed due for this petition. If a fee is due, kindly charge the sum to deposit account 50-0573.

Respectfully submitted,
SUKANTA BANERJEE, et al.

BY: 

DANIEL A. MONACO
Registration Number 30,480
Drinker Biddle & Reath LLP
One Logan Square
18th and Cherry Streets
Philadelphia, PA 19103-6996
Tel: (215) 988-3312
Fax: (215) 988-2757
Attorney for the Applicant(s)

MAR 23 2006



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/032,657	12/28/2001	Sukanta Banerjee	42970-7CI1

Daniel A Monaco Esq
Drinker & Biddle & Reath LLP
One Logan Square 18th
and Cherry Streets
Philadelphia, PA 19103-6996

CONFIRMATION NO. 6168
ABANDONMENT/TERMINATION
LETTER

Date Mailed: 03/09/2006

NOTICE OF ABANDONMENT UNDER 37 CFR 1.53 (f) OR (g)

The above-identified application is abandoned for failure to timely or properly reply to the Notice to File Missing Parts (Notice) mailed on 01/29/2002.

- No reply was received.

If a complete reply to the notice was previously filed by applicant within the time period set forth in the notice, applicant may request for reconsideration of the holding of abandonment within 2 months from the mailing of this notice of abandonment by filing a petition to withdraw the holding of abandonment under 37 CFR 1.181(a). No petition fee is required. The petition must be accompanied by a true copy of the originally filed reply and the item (s) identified in one of the following:

1. A properly itemized date-stamped postcard receipt (see MPEP § 503);
2. If the originally filed reply included a certificate of mailing or transmission in compliance with 37 CFR 1.8(a), a copy of the certificate of mailing or transmission and a statement in compliance with 37 CFR 1.8(b) (see MPEP §§ 512); or
3. If the reply was filed via Express Mail, a submission satisfying the requirements of 37 CFR 1.10(e) including, for example, a copy of the Express Mail mailing label showing the "date-in" (see MPEP § 513).

Any petition to withdraw the holding of abandonment should be directed to OIPE.

If applicant did not previously file a complete reply within the time period set forth in the notice, applicant may file a petition to revive the application under 37 CFR 1.137.

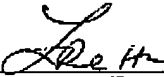
Under 37 CFR 1.137(a), a petition requesting the application be revived on the grounds of **UNAVOIDABLE DELAY** must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied by: (1) an adequate showing of the cause of unavoidable delay; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(l); and (4) a terminal disclaimer if required by 37 CFR 1.137(d). See MPEP § 711.03(c) and Form PTO/SB/61.

Under 37 CFR 1.137(b), a petition requesting the application be revived on the grounds of **UNINTENTIONAL DELAY** must be filed promptly after applicant becomes aware of the abandonment and such petition must be accompanied by: (1) a statement that the entire delay was unintentional; (2) the required reply to the above-

identified Notice; (3) the petition fee set forth in 37 CFR 1.17(m); and (4) a terminal disclaimer if required by 37 CFR 1.137(d). See MPEP § 711.03(c) and Form PTO/SB/64.

Any questions concerning petitions to revive should be directed to the "Office of Petitions" at (571) 272-3282.

*A copy of this notice **MUST** be returned with the reply.*



Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199, or 1-800-972-6382
PART 2 - COPY TO BE RETURNED WITH RESPONSE

APPENDIX A

MAR 23 2006

PATENT
DOCKET NO. 4363-4006
Express Mail #EV 094 892 595US**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s) : Sukanta Banerjee et al.
Serial No. : 10/032,657
Filing Date : ~~8~~ December 28, 2001
Group Art Unit: : 1645
For : MULTIANALYTE MOLECULAR ANALYSIS USING APPLICATION-SPECIFIC RANDOM PARTICLE ARRAYS

Commissioner For Patents
Washington, D.C. 20231

BOX: Missing Parts

**RESPONSE TO NOTICE TO FILE
MISSING PARTS OF APPLICATION**

In response to the Communication dated January 29, 2002 entitled "Notice To File Missing Parts of Application", Applicants submit herewith an executed Declaration and Power of Attorney and Petition for Two Month Extension of Time. Payment of the applicable surcharge of \$65.00 for the Missing Parts and \$200.00 for the Petition Fee for small entity are enclosed together with a copy of Notice.

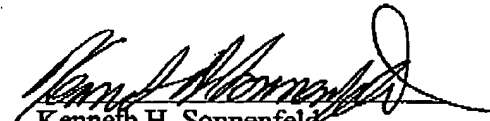
The Commissioner is hereby authorized to charge any additional fees or credit any overpayment which may be required for this response to Deposit Account No. 13-4500. Order No. 4363-4006. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,

Dated: May 6, 2002

Morgan & Finnegan
345 Park Avenue
New York, New York 10154
(212) 758-4800
(212) 751-6849 (Fax)

700181 v1



Kenneth H. Sonnenfeld
Registration No. 33,285

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MAR 23 2006

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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
10/032,657	10/28/2001	Sukanta Banerjee	464-1045 US

CONFIRMATION NO. 6168

FORMALITIES LETTER

OC000000007386323

Julie Bowker
Suite 2918
60 East 42nd Street
New York, NY 10165

Date Mailed: 01/29/2002

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is missing.
A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(l) of \$65 for a small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 65.

The application is informal since it does not comply with the regulations for the reason(s) indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

- Substitute drawings in compliance with 37 CFR 1.84 because:
 - drawing sheets do not have the appropriate margin(s) (see 37 CFR 1.84(g)). Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch);

*A copy of this notice **MUST** be returned with the reply.*

03/23/08 12:57 FAX

DB&R PHILA.

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Lib C

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

Docket No. 4363-4006

**COMBINED DECLARATION AND POWER OF ATTORNEY FOR
ORIGINAL, DESIGN, NATIONAL STAGE OF PCT, SUPPLEMENTAL,
DIVISIONAL, CONTINUATION OR CONTINUATION-IN-PART APPLICATION**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**MULTIANALYTE MOLECULAR ANALYSIS USING APPLICATION-SPECIFIC RANDOM
PARTICLE ARRAYS**

the specification of which

- a. ☐ is attached hereto
- b. ☒ was filed on 12/28/2001 as application Serial No. 10/032,657 and was amended on . (if applicable)

PCT FILED APPLICATION ENTERING NATIONAL STAGE

- c. ☐ was described and claimed in International Application No. filed on and as amended on . (if any).

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 C.F.R. § 1.56.

I hereby specify the following as the correspondence address to which all communications about this application are to be directed:

**27123**

PATENT TRADEMARK OFFICE

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, N.Y. 10154

DIRECT TELEPHONE CALLS TO: Kenneth Sonnenfeld

↑ AFFIX CUSTOMER NO. LABEL ABOVE ↑

Docket No. 4363-4006

- ☐ I hereby claim foreign priority benefits under Title 35, United States Code § 119 (a)-(d) or under § 365(b) of any foreign application(s) for patent or inventor's certificate or under § 365(a) of any PCT international application(s) designating at least one country other than the U.S. listed below and also have identified below such foreign application(s) for patent or inventor's certificate or such PCT international application(s) filed by me on the same subject matter having a filing date within twelve (12) months before that of the application on which priority is claimed:
- ☒ The attached 35 U.S.C. § 119 claim for priority for the application(s) listed below forms a part of this declaration.

Country/PCT	Application Number	Date of filing (day, month, yr)	Date of issue (day, month, yr)	Priority Claimed
				<input type="checkbox"/> Y <input type="checkbox"/> N
				<input type="checkbox"/> Y <input type="checkbox"/> N
				<input type="checkbox"/> Y <input type="checkbox"/> N

- ☒ I hereby claim the benefit under 35 U.S.C. § 119(e) of any U.S. provisional application(s) listed below.

Provisional Application No.	Date of filing (day, month, yr)
60/213,106	21 June 2000

ADDITIONAL STATEMENTS FOR DIVISIONAL, CONTINUATION OR CONTINUATION-IN-PART OR PCT INTERNATIONAL APPLICATION(S) DESIGNATING THE U.S.)

I hereby claim the benefit under Title 35, United States Code § 120 of any United States application(s) or under § 365(c) of any PCT international application(s) designating the U.S. listed below.

PCT/US01/20179	06/21/2001	Patented
US/PCT Application Serial No.	Filing Date	Status (patented, pending, abandoned)/ U.S. application no. assigned (For PCT)
US/PCT Application Serial No.	Filing Date	Status (patented, pending, abandoned)/ U.S. application no. assigned (For PCT)

- ☒ In this continuation-in-part application, insofar as the subject matter of any of the claims of this application is not disclosed in the above listed prior United States or PCT international application(s) in the manner provided by the first paragraph of Title 35, United States Code, § 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, § 1.56(a) which occurred between the filing date of the prior application(s) and the national or PCT international filing date of this application.

Docket No. 4363-4006

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or Imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint the following attorneys and/or agents with full power of substitution and revocation, to prosecute this application, to receive the patent, and to transact all business in the Patent and Trademark Office connected therewith: David H. Pfeffer (Reg. No. 19,825), Harry C. Marcus (Reg. No. 22,390), Robert E. Paulson (Reg. No. 21,046), Stephen R. Smith (Reg. No. 22,615), Kurt E. Richter (Reg. No. 24,052), J. Robert Dailey (Reg. No. 27,434), Eugene Moroz (Reg. No. 25,237), John F. Sweeney (Reg. No. 27,471), Arnold I. Rady (Reg. No. 26,601), Christopher A. Hughes (Reg. No. 26,914), William S. Feiler (Reg. No. 26,728), Joseph A. Calvaruso (Reg. No. 28,287), James W. Gould (Reg. No. 28,859), Richard C. Komson (Reg. No. 27,913), Israel Blum (Reg. No. 26,710), Bartholomew Verdirame (Reg. No. 28,483), Maria C.H. Lin (Reg. No. 29,323), Joseph A. DeGirolamo (Reg. No. 28,595), Michael P. Dougherty (Reg. No. 32,730), Seth J. Atlas (Reg. No. 32,454), Andrew M. Riddles (Reg. No. 31,657), Bruce D. DeRenzi (Reg. No. 33,676), Mark J. Abate (Reg. No. 32,527), John T. Gallagher (Reg. No. 35,516), Steven F. Meyer (Reg. No. 35,613), Kenneth H. Sonnenfeld (Reg. No. 33,285), Tony V. Pezzano (Reg. No. 38,271), Andrea L. Wayda (Reg. 43,979), Walter G. Hanchuk (Reg. No. 35,179), John W. Osborne (Reg. No. 36,231), Robert K. Goethals (Reg. No. 36,813), Peter N. Fill (Reg. No. 38,876), Mary J. Morry (Reg. No. 34,398) and Kenneth S. Weitzman (Reg. No. 36,306) of Morgan & Finnegan, L.L.P. whose address is: 345 Park Avenue, New York, New York, 10154; and Michael S. Marcus (Reg. No. 31,727), and John E. Hoel (Reg. No. 26,279), of Morgan & Finnegan, L.L.P., whose address is 1775 Eye Street, Suite 400, Washington, D.C. 20006.

- ☐ I hereby authorize the U.S. attorneys and/or agents named hereinabove to accept and follow instructions from _____ as to any action to be taken in the U.S. Patent and Trademark Office regarding this application without direct communication between the U.S. attorneys and/or agents and me. In the event of a change in the person(s) from whom instructions may be taken I will so notify the U.S. attorneys and/or agents named hereinabove.

Full name of sole or first inventor:	<u>Sukanta BANERJEE</u>	
Inventor's signature*	<u>Sukanta Banerjee</u>	<u>04-25-2002</u> Date
Residence:	<u>US</u>	
Citizenship:	<u>India</u>	
Post Office Address:	<u>7 Petunia Drive, Apt #1H, North Brunswick, NJ, 08902</u>	
Full name of second inventor:	<u>Michael SEUL</u>	
Inventor's signature*	<u>Michael Seul</u>	<u>4.25.02</u> Date
Residence:	<u>US</u>	
Citizenship:	<u>Germany</u>	
Post Office Address:	<u>84 Pleasant Avenue, Fanwood, NJ, 07023</u>	

Docket No. 4363-4006

*Before signing this declaration, each person signing must:

1. Review the declaration and verify the correctness of all information therein; and
2. Review the specification and the claims, including any amendments made to the claims.

After the declaration is signed, the specification and claims are not to be altered.

To the inventor(s):

The following are cited in or pertinent to the declaration attached to the accompanying application:

Title 37, Code of Federal Regulation, §1.56

Duty to disclose information material to patentability

- (a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§ 1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

- (b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:

Docket No. 4363-4006

- (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of patentability. A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.
- (c) Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:
- (1) Each inventor named in the application;
 - (2) Each attorney or agent who prepares or prosecutes the application; and
 - (3) Every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application.
- (d) Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent, or inventor.
- (e) In any continuation-in-part application, the duty under this section includes the duty to disclose to the Office all information known to the person to be material to patentability, as defined in paragraph (b) of this section, which became available between the filing date of the prior application and the National or PCT international filing date of the continuation-in-part application.

Title 35, U.S. Code § 101

Inventions patentable

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Title 35 U.S. Code § 102

Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless —

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent,
- (b) the invention was patented or described in a printed publication in this or foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States, or
- (c) he has abandoned the invention, or
- (d) the invention was first patented or caused to be patented, or was the subject of an inventor's certificate, by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application for patent or inventor's certificate filed more than twelve months before the filing of the application in the United States, or

Docket No. 4363-4006

(e) The invention was described in—

- (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
- (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a); or

(f) he did not himself invent the subject matter sought to be patented, or

(g) (1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Title 35, U.S. Code § 103

103. Conditions for patentability; non-obvious subject matter

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- (b) (1) Notwithstanding subsection (a), and upon timely election by the applicant for patent to proceed under this subsection, a biotechnological process using or resulting in a composition of matter that is novel under section 102 and nonobvious under subsection (a) of this section shall be considered nonobvious if—
 - (A) claims to the process and the composition of matter are contained in either the same application for patent or in separate applications having the same effective filing date; and
 - (B) the composition of matter, and the process at the time it was invented, were owned by the same person or subject to an obligation of assignment to the same person.
- (2) A patent issued on a process under paragraph (1)—
 - (A) shall also contain the claims to the composition of matter used in or made by that process, or
 - (B) shall, if such composition of matter is claimed in another patent, be set to expire on the same date as such other patent, notwithstanding section 154.
- (3) For purposes of paragraph (1), the term "biotechnological process" means—

Docket No. 4363-4006

- (A) a process of genetically altering or otherwise inducing a single- or multi-celled organism to--
 - (i) express an exogenous nucleotide sequence,
 - (ii) inhibit, eliminate, augment, or alter expression of an endogenous nucleotide sequence, or
 - (iii) express a specific physiological characteristic not naturally associated with said organism;
 - (B) cell fusion procedures yielding a cell line that expresses a specific protein, such as a monoclonal antibody; and
 - (C) a method of using a product produced by a process defined by subparagraph (A) or (B), or a combination of subparagraphs (A) and (B).
- (c) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Title 35, U.S. Code § 112 (in part)

Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Title 35, U.S. Code, § 119

Benefit of earlier filing date in foreign country; right of priority

- (a) An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, or in a WTO member country, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.
- (b) (1) No application for patent shall be entitled to this right of priority unless a claim is filed in the Patent and Trademark Office, identifying the foreign application by specifying the application number on that foreign application, the intellectual property authority or country in or for which the application was filed, and the date of filing the application, at such time during the pendency of the application as required by the Director.
- (2) The Director may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed claim under this section.

Docket No. 4363-4006

- (3) The Director may require a certified copy of the original foreign application, specification, and drawings upon which it is based, a translation if not in the English language, and such other information as the Director considers necessary. Any such certification shall be made by the foreign intellectual property authority in which the foreign application was filed and show the date of the application and of the filing of the specification and other papers.
- (c) In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.
- (d) Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing.
- (e) (1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application.
- (2) A provisional application filed under section 111(b) of this title may not be relied upon in any proceeding in the Patent and Trademark Office unless the fee set forth in subparagraph (A) or (C) of section 41(a)(1) of this title has been paid.
- (3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.
- (f) Applications for plant breeder's rights filed in a WTO member country (or in a foreign UPOV Contracting Party) shall have the same effect for the purpose of the right of priority under subsections (a) through (c) of this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents.
- (g) As used in this section—
- (1) the term "WTO member country" has the same meaning as the term is defined in section 104(b)(2) of this title; and
- (2) the term "UPOV Contracting Party" means a member of the International Convention for the Protection of New Varieties of Plants.

Docket No. 4363-4006

Title 35, U.S. Code, § 120

Benefit or earlier filing date in the United States

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application. *No application shall be entitled to the benefit of an earlier filed application under this section unless an amendment containing the specific reference to the earlier filed application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this section. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this section.*

Please read carefully before signing the Declaration attached to the accompanying Application. If you have any questions, please contact Morgan & Finnegan, L.L.P.

-vi-

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Docket No. 4363-4006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Sukanta Banerjee et al.

Group Art Unit: 1645

Serial No.: 10/032,657

Examiner: TBA

Filed: December 28, 2001

For: MULTIANALYTE MOLECULAR ANALYSIS USING APPLICATION-SPECIFIC
RANDOM PARTICLE ARRAYS

PETITION AND FEE FOR EXTENSION OF TIME (37 C.F.R. § 1.136(a))

Commissioner for Patents
Washington, DC 20231

Sir:

1. This is a petition for an extension of time for Notice to File Missing Parts
2. The communication in connection with the matter for which this extension is requested
 - ☒ is filed herewith.
 - ☐ has been filed on _____.
3. ☒ Applicant(s) is/are entitled to Small Entity Status.
 - ☐ Statement has already been filed

4.

	<u>Total Months Requested</u>	<u>Fee for Other than Small Entity</u>	<u>Fee for Small Entity</u>
a. <input type="checkbox"/> one month		\$110.00	\$55.00
b. <input checked="" type="checkbox"/> two months		\$400.00	\$200.00
c. <input type="checkbox"/> three months		\$920.00	\$460.00
d. <input type="checkbox"/> four months		\$1,440.00	\$720.00
e. <input type="checkbox"/> five months		\$1,960.00	\$980.00
f. <input type="checkbox"/> An extension for _____ months has already been secured for filing the above-identified communication and the fee paid therefor of \$_____ is deducted from the total fee due for the total months of extension now requested. The fee for this extension (\$ _____), minus the fee previously paid (\$ _____) equals \$_____ (total fee due).			

5. ☒ A check in the amount of \$200.00 to cover the extension fee is attached.
6. ☐ Charge fee to Deposit Account No. 13-4500, Order No. _____. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.


Docket No. 4363-4006

7. ☒ The Commissioner is hereby authorized to charge any additional fees which may be required by this paper, or credit any overpayment to Deposit Account No. 13-4500. Order No. 4363-4006. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,
MORGAN & FINNEGAN, L.L.P.

Dated: May 6, 2002

By:


Kenneth H. Sonnenfeld
Registration No. 33,285

Correspondence Address:

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026275 1-0210 260

MORGAN & FINNEGAN, L.L.P.
ATTORNEYS AT LAW
345 PARK AVE.
NEW YORK, NY 10154

DATE 5/6/03 \$ 65,000.00 DOLLARS

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CITIBANK N.A.
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NEW YORK, NY 10043

FOR 4263-4006

John C. Varril

⑈026275⑈ ⑆021000089⑆ 400 37291776⑈

QUARTZ & SAFETY

Y230157

MAR 23 2006

Docket No. 4363-4006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Sukanta Banerjee et al.

Group Art Unit: 1645

Serial No.: 10/032,657

Examiner: TBA

Filed: 7 December 28, 2001

For: MULTIANALYTE MOLECULAR ANALYSIS USING APPLICATION-SPECIFIC RANDOM
PARTICLE ARRAYSEXPRESS MAIL CERTIFICATE

Express Mail Label No.: EV 094 892 595US

Date of Deposit: May 6, 2002

I hereby certify that the following attached paper(s) and/or fee

1. Response to Notice to File Missing Parts Application;
2. Copy of Notice to File Missing Parts;
3. Executed Combined Declaration and Power of Attorney;
4. Petition for Two Month Extension of Time;
5. Check of \$65.00 for Missing Parts fee;
6. Check of \$200.00 for Petition fee; and
7. Return Postcards.

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Susan Shen

(Typed or printed name of person mailing papers(s) and/or fee)



(Signature of person mailing paper(s) and/or fee)

Correspondence Address:

MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154-0053
(212) 758-4800 Telephone
(212) 751-6849 Facsimile

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DATE 5/6/02 \$ 200.00 DOLLARS

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MORGAN & FINNEGAN, L.L.P.
ATTORNEYS AT LAW
346 PARK AVE.
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CITIBANK
CITIBANK N.A.
130 EAST 57th STREET
20th Fl., New York, NY 10022

FOR 4363-4006

John C. Varvil

⑈026273⑈ ⑈021000089⑈ 400 3726776⑈

Case No. 4363-4006 Serial No. 10/032,657
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APPENDIX B

Case No. 4363-4006 Serial No. 10/032,657Date Mailed MAY 6, 2002 ATTY KHS

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6. Check of \$200.00 for Petition fee;
7. Express Mail No. EV 094 892 595US; and
8. Return receipt postcard





2002 MAY 13 1P 3 15

MORGAN & FINNEGAN LLP

MORGAN & FINNEGAN, L.L.P.

345 PARK AVENUE

NEW YORK, NEW YORK 10154-0053



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APPENDIX C

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